

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 16, 27, 35, and 43 will have been amended while claims 16-28 and 35- 44 will have been re-submitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, for the indication of the allowability of claims 1-15 and 29-34, for the acceptance of the drawings filed in the present application on January 30, 2004, for the acknowledgment of Applicant's claim for priority under 35 U.S.C. § 119 and receipt of the certified copies of the priority documents, as set forth in the Official Action.

Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on April 1, 2004 and July 6, 2004 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner has objected to claims 21-28 and 37-44 under 37 C.F.R. § 1.75 as being a substantial duplicate of claims 1, 5, 6, 10, 11, 15, 16, 20 and 29-36, respectively. However, Applicant respectfully traverses the above objection.

MPEP § 706.03(k) specifies that "court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways, indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim”.

In the present application, the objected to claims are not substantial duplicates of other claims but differ therefrom in scope. For example, claim 21 is associated with allowed claim 1. However, allowed claim 1 does not positively recite the transmitter recited in claim 21. Thus, claim 21 is not a duplicate of allowed claim 1, nor “so close in content” to allowed claim 1. The other objected to claims 22-28 and 37-44 are also not duplicates of allowed claims 5, 6, 10, 11, 15, 16, 20, and 29-36, nor “so close in content” to these claims for the substantially same reason. Therefore, Applicant respectfully requests that the Examiner withdraw the objection.

The Examiner has rejected claims 16-20, 27, 28, 35, 36, 43 and 44 under 35 U.S.C. § 103(a) as being unpatentable over BEAK et al. (U.S Patent No. 5,798, 845) in view of BASHOURA et al. (U.S Patent No.5862,202). However, Applicant respectfully traverses the above rejection.

As noted above, Applicant has amended claims 16, 27, 35, and 43 for consideration by the Examiner. Applicant respectfully traverses the above rejection based on claims 16-20, 27, 28, 35, 36, 43 and 44 and will discuss said rejection with respect to the pending claims in the present application as will be set forth herein below. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 16-20 and 27-28 generally relate to an image data communication apparatus which is connected to an image data source and to a network, and which transmits the image data attached to an e-mail to a receiving apparatus via the network. The e-mail includes a mail from command and a mail message. The image data is attached to the e-mail as an openable document. The image data communication apparatus includes a memory and a panel section configured to select e.g., information regarding an identification of at least one user and a mail address of the at least one user. The image data communication apparatus sets the information regarding the identification of the user and the mail address of the user selected by the panel section, into the mail message of the e-mail to which the image data is attached. Thereby, opening, at the receiving apparatus, of the attached image data is not required to determine the information regarding the identification of the user. As used herein, the term "determine" includes, in addition to its ordinary meaning, as an example only, identifying who sent the message, as set forth e.g., at page 2, line 3, as well as finding out and/or identifying an address of a sender and accessing the identification and/or the address of the sender. Claims 35-36 and 43-44 recite related methods.

BAEK et al. relates to a facsimile system which prints a user's common name (such as a common company name) and a user's unique name (such as his/her name) at the top of the document received by a recipient. However, BAEK et al. does not relate to an Internet facsimile apparatus, but to an ordinary facsimile apparatus. Thus, BEAK et al. contains no disclosure about an e-mail.

Therefore, BEAK et al. cannot teach an image data apparatus which transmits image data attached to an e-mail to a receiving apparatus via a network, and an e-mail which includes a mail from command and a mail message. BEAK et al. also cannot disclose the image data attached to the e-mail as an openable document.

Further, BEAK et al. does not teach a memory which stores information regarding an identification of at least one user of the image data communication apparatus and a mail address of the at least one user. BEAK et al. also does not disclose a panel section which selects the information regarding an identification of at least one user and the mail address of the at least one user stored in the memory. Additionally, BEAK et al. also does not disclose a controller which sets the information regarding the identification of the user and the mail address of the user selected by the panel section, into the mail message of the e-mail to which the image data is attached.

Furthermore, BEAK et al. cannot obtain the advantage of pending claims that opening, at the receiving apparatus, of the image data attached to the e-mail is not required to determine the information regarding the identification of the user, since BEAK et al. merely relates to an ordinary facsimile apparatus in which a recipient can directly determine the identification of the user by reading the identification of the user printed on the top of a document.

In addition, regarding the mail address of the user in the present invention, it is not printed at the top of the document since it is set into the mail message of the e-mail.

Thus, claims 16-20, 27, 28, 35, 36, 43, and 44 are clearly distinguished over BEAK et al., because BAEK at el. relates to the ordinary facsimile apparatus which does not utilize an e-mail and thus cannot set the information regarding the

identification of the user and the mail address of the user, into the mail message of the e-mail.

Therefore, it is respectfully submitted that the features recited in Applicant's resubmitted claims are not disclosed in BAEK et al. cited by the Examiner.

BASHOURA et al. relates to a facsimile routing system in which local fax machine 1 dials a number to fax director 3, and fax director 3 delivers the dialed number to local computer 5. Local computer 5 determines whether the dialed number matches with a number in table 7. When the dialed number matches with a number in table 7, local fax machine 1 sends a fax to the fax director 3. Fax director 3 converts the fax into a computer file and delivers the computer file to local computer 5. Then, local computer 5 generates an e-mail message to a recipient and delivers, to fax sender 9, the e-mail with the computer file attached, for delivery into the Internet 15. However, with respect to an e-mail transmission, BASHOURA et al. merely teaches "the E-mail software 53 in the local computer 5 generates an E-mail message to the recipient (or no message at all) and delivers that E-mail into the fax sender 9 for delivery in to the Internet 15 with the computer file attached. Again, the local computer 5 can instead deliver the E-mail with the computer file attached to the fax director 3 which, in turn, delivers it over the lines 11 to the fax sender 9" (see col. 4, line 67 through col. 5, line 6). In other words, BASHOURA et al. discloses nothing more than a general explanation of delivering an E-mail with the computer file attached.

Thus, BASHOURA et al. merely contains disclosures about a technology similar to the prior art Internet facsimile apparatus. In the prior art Internet facsimile apparatus, when a recipient receives an image data attached to an e-mail, the recipient

first has to open the e-mail, and then also has to open the image data attached to the e-mail. In other words, the recipient can not determine the identification of the user without opening the image data attached to the e-mail, because the identification of the user is not contained in the e-mail. Rather, the identification of e.g., local computer 5 is contained in e.g., the mail message of the e-mail. This means that, in the prior art Internet facsimile apparatus, the recipient needs to perform additional operations to determine the identification of the user.

However, the present invention enables the recipient to determine the identification of the user (not the transmitting facsimile apparatus) without opening the image data attached to the e-mail, but merely by opening the e-mail. As a result of the features of the present invention, the recipient does not need to also open the image data attached to the e-mail in order to determine the identification of the user.

Thus, the pending claims are significantly different from the ordinary facsimile apparatus, and thus claims 16-20, 27, 38, 35, 36, 43, and 44 are clearly distinguished over BASHOURA et al.

In addition, regarding the mail address of the user, BASHOURA et al. does not contain any disclosures about setting the mail address of the user (not the transmitting facsimile apparatus) selected by the panel section, into the mail message of the e-mail to which the image data is attached, since BASHOURA et al. provides a general explanation of delivering an e-mail with the computer file attached.

Therefore, it is respectfully submitted that the features recited in Applicant's resubmitted claims are not taught or disclosed in BASHOURA et al. cited by the Examiner. The claims 16-20, 27, 28, 35, 36, 43, and 44 are also submitted to be

patentable over the Examiner's proposed combination. In particular, since neither BEAK et al. nor BASHOURA et al. disclosed the features recited in Applicant's claims 16-20, 27, 28, 35, 36, 43, and 44, the claims 16-20, 27, 28, 35, 36, 43, and 44 are clearly distinguished over the combination of BAET et al. and BASHOURA et al.

Further, the Examiner has not set forth a proper motivation to combine BAET et al. with BASHOURA et al. While BAET et al. relates to a conventional facsimile apparatus, BASHOURA et al. merely provides the general explanation of delivering an E-mail with a computer file attached. Further, in BASHOURA et al., it is not local fax machine 1 (or fax director 3) but local computer 5 that attaches the computer file to the E-mail.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection and an indication of the allowability of all the claims pending in the present application, in due course.

Applicant further wishes to make of record a personal interview conducted between Applicant's undersigned representative and Examiner Lee on January 25, 2005. The above-noted interview was attended by the undersigned representative of Applicant's assignee as well as Mr. Hiroshi Takahashi of Panasonic Communications Co., Ltd., the assignee of the present application.

Initially, Applicant wishes to thank Examiner Lee for his courtesy and cooperation in scheduling and conducting the above-noted interview. Applicant further wishes to thank the Examiner for his cooperative and positive attitude towards the interview and towards the present invention.

During the above-noted interview, Applicant discussed the outstanding rejection in the present application and in this regard, pointed out to the Examiner that the objected to claims are not identical with the remaining claims in the present application. In other words, Applicant showed the Examiner a side-by-side comparison of the various claims asserted to be duplicates and emphasized the significant difference in recitations of the asserted to be duplicate claims. As a result, the Examiner indicated that the objection to the claims will be withdrawn.

Applicant further discussed the outstanding prior art rejection in the present application and pointed out the shortcomings of the references with respect to the features recited in the various claims. At the conclusion of the interview, the Examiner indicated that he understood the differences asserted by the Applicant's representative. The Examiner further indicated that he will reconsider the outstanding rejection and upon conducting an update search and upon further review of the disclosure of the references cited against the rejected claims in the present application.

During the above-noted interview, Applicant also noted for the Examiner that the present application is one of 15 continuation applications that all claim priority under 35 U.S.C. § 120 from parent U.S. Patent Application No. 09/461,402, which is now U.S. Patent No. 6,710,894 which issued on March 23, 2004.

During the above-noted interview, Applicant presented the Examiner with a chart listing the 15 continuation applications and pointing out the differences between the subject matter to which the claims of each of the 15 continuations (as well as the parent) were directed. Applicant prepared and gave this chart to the Examiner to facilitate examination of all the continuation applications.

Applicant's representative also pointed out that since the subject matter of each of the applications is directed to a different aspect (or combination of aspects) of the present invention, Applicant does not believe that any type of obviousness type double patenting rejection is appropriate. However, Applicant respectfully requested that the Examiner consider the claims of all of these applications to determine for himself whether a obviousness type double patenting rejection is appropriate. Applicant further indicated that if the Examiner decides that such a rejection is indicated, he would consider filing a Terminal Disclaimer to overcome such rejection.

Additionally, during the above-noted interview, Applicant's representative discussed several of the documents cited in the Information Disclosure Statements filed in the present application. In this regard, Applicant noted and expressly directed the Examiner's attention to Japanese Laid-Open Patent Publication HEI 10-307769, to the Assignee of the present application and to Japanese Laid-Open Patent Publication HEI 08-542326 to Matsushita Electric Industrial Co., Ltd.

Applicant pointed out that both of these documents relate to the general subject matter of returning an error message which is claimed in several of the co-pending and commonly assigned continuation applications discussed above.

An English language translation and an English language patent family member of the above-noted Japanese documents (filed together with the Information Disclosure Statement) were also brought to the Examiner's attention and portions of the English language translation and patent family member were noted to relate to return of an error message. The Examiner particularly noted portions of the translation and family member that discuss the feature of returning an error message.

Applicant further respectfully suggested that in view of the discussion of the subject matter of various ones of the continuation applications, it would be obviously efficient to conduct examination of these 15 applications within a short time period after the interview in the present application.

At the conclusion of the interview, Applicant's undersigned representative expressed his appreciation to the Examiner for taking the time out of his busy schedule to conduct an extensive interview regarding the present application as well as regarding the co-pending applications. Applicant again thanks the Examiner for his courtesy as well as for his positive and cooperative nature as exhibited during the above-noted interview.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended some of the rejected claims and has resubmitted the objected to and rejected claims for consideration by the Examiner. With respect to the rejected claims, Applicant has pointed out the features thereof and has contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

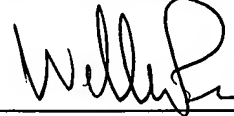
Applicant has also included a summary of the substance of an interview for the personal interview conducted on January 27, 2005 and thanked the Examiner for his cooperation regarding the interview.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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